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| EXAMINER | |
|---|---|
| COY, NICOLE A | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 3672 | |

DATE MAILED: 08/29/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/767,656 | HEPBURN ET AL. | |
| | Examiner | Art Unit | |
| | Nicole Coy | 3672 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *16 June 2006*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1,3-13,15-28,30-40 and 42-47* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,3-13,15-28,30-40 and 42-47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 11, 13, 15-18, 38, 40, 42, 45, and 46 are rejected under 35 U.S.C. 102(e) as being anticipated by Kiest, Jr. et al. (USP 6,994,118).

With respect to claim 11, Kiest, Jr. et al. discloses a completion system for a well having a branch wellbore (52) extending outwardly from a window in a parent wellbore (50), the system comprising: a tubular string (34) having a portion positioned within the window; and a sealing material (56, 58) on the tubular string portion, the sealing material (56, 58) being swellable in the well by increasing a volume of the sealing material, to thereby form a first seal between the tubular string portion and the window (see column 2 lines 43-49).

With respect to claims 13 and 40, Kiest, Jr. et al. discloses that the sealing material swells in response to exposure to water in the well (see column 2 lines 43-49).

With respect to claim 15, Kiest, Jr. et al. discloses that the tubular string portion extends within the parent wellbore, the sealing material forming a second seal (56 and 58) between the tubular string portion and the parent wellbore.

With respect to claim 16, Kiest, Jr. et al. discloses that the tubular string portion has an opening (24) formed through a sidewall thereof, the opening providing fluid communication between an interior of the tubular string and the parent wellbore.

With respect to claims 17 and 42, Kiest, Jr. et al. discloses that the opening is positioned between the first seal and a second seal formed by the sealing material between the tubular string portion and the parent wellbore (see figure 3).

With respect to claims 18 and 45, Kiest, Jr. et al. discloses that the sealing material is a rubber compound (see column 2 lines 10-14).

With respect to claim 38, Kiest, Jr. et al. discloses a completion system for a well having a branch wellbore extending outwardly from a window in a parent wellbore, the system comprising: an assembly (38) positioned in the parent wellbore (50), the assembly having an opening formed through a sidewall thereof, the opening being aligned with the window (see figure 2); and a sealing material (56 and 58) on the assembly, the sealing material being swellable in the well by increasing a volume of the sealing material, to thereby form a first seal circumferentially about the opening (see column 2 lines 43-49).

With respect to claim 46, Kiest, Jr. et al. discloses that the assembly includes a tubular structure (34), and wherein the first seal (56, 58) provides a sealed flowpath

between the branch wellbore and an interior of the tubular structure (see figures 2 and 3).

3. Claims 11, 13, 15-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Meijers et al. (USP 5,340,160).

With respect to claim 11, Meijers et al. discloses a completion system for a well having a branch wellbore extending outwardly from a window in a parent wellbore (see figure 8), the system comprising: a tubular string (6,8) having a portion positioned within the window; and a sealing material (111) on the tubular string portion, the sealing material (111) being swellable in the well by increasing a volume of the sealing material (see column 6 lines 28-32), to thereby form a first seal between the tubular string portion and the window (see figure 8).

With respect to claims 13 and 40, Meijers et al. discloses that the sealing material (111) swells in response to exposure to water in the well (see column 6 lines 28-32).

With respect to claims 15 and 42, Meijers et al. discloses that the tubular string portion extends within the parent wellbore (6), the sealing material forming a second seal (111, see figure 8) between the tubular string portion and the parent wellbore.

With respect to claim 16, Meijers et al. discloses that the tubular string portion has an opening (3a) formed through a sidewall thereof, the opening providing fluid communication between an interior of the tubular string and the parent wellbore.

With respect to claim 17,Meijers et al. discloses that the opening is positioned between the first seal and a second seal formed by the sealing material between the tubular string portion and the parent wellbore (see figure 8).

With respect to claims 18 and 45, Meijers et al. discloses that the sealing material (111) is a rubber material (see column 6 line 30).

With respect to claim 38, Meijers et al. discloses a completion system for a well having a branch wellbore extending outwardly from a window in a parent wellbore, the system comprising: an assembly (6) positioned in the parent wellbore (see figure 8), the assembly having an opening formed through a sidewall thereof (see figure 8), the opening being aligned with the window (see figure 8); and a sealing material (111) on the assembly, the sealing material being swellable in the well by increasing a volume of the sealing material, to thereby form a first seal circumferentially about the opening (see column 6 lines 28-32).

With respect to claim 46, Meijers et al. discloses that the assembly includes a tubular structure, and wherein the first seal (111) provides a sealed flowpath between the branch wellbore and an interior of the tubular structure (see figure 8).

## *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

5. Claims 1, 3, 8, 10, 21, 22, 25, 26, 28, 30-34, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kiest, Jr. et al.

With respect to claim 1, Kiest, Jr. et al. teaches positioning an assembly (34) in the window (see figures 2 and 3); and swelling a sealing material (56,58) on the assembly by increasing a volume of the sealing material, so that a first seal is formed between the assembly and the window (see column 2 lines 43-49). Kiest, Jr. et al. does not disclose a method of completing a well. However, the assembly in Kiest, Jr. et al. is capable of being used in a wellbore, and it would have been obvious to use the assembly as taught by Kiest, Jr. in a wellbore in order to form a water tight seal between a main wellbore and a lateral bore in order to complete a well.

With respect to claim 3, Kiest, Jr. et al. teaches the positioning step further comprises positioning the assembly at least partially in the parent wellbore and at least partially in the branch wellbore (see figures 2 and 3).

With respect to claims 8 and 34, Kiest, Jr. et al. discloses that the sealing material is a rubber compound (see column 2 lines 10-14).

With respect to claims 10 and 36, Kiest, Jr. et al. discloses that the sealing material swells in response to exposure to water in the well (see column 2 lines 43-49).

With respect to claim 21, Kiest, Jr. et al. discloses a method of completing a well having a branch wellbore extending outwardly from a window in a parent wellbore, the method comprising the steps of: positioning an assembly (38) in the parent wellbore (50); forming an opening through a sidewall of the assembly (see figure 3); aligning the assembly with the window (see figure 3 and column 4 lines 62-63); and swelling a

sealing material (56,58) on the assembly by increasing a volume of the sealing material, so that a first seal is formed about the opening (see column 2 lines 43-49).

With respect to claim 22, Kiest, Jr. et al. discloses that the forming step (figure 3) is performed after the positioning step (figure 2).

With respect to claim 25, Kiest, Jr. et al. discloses that the forming step is performed before the swelling step (see column 5 lines 28-51).

With respect to claim 26, Kiest, Jr. et al. discloses that the aligning step further comprises aligning the opening with the window (see column 4 line 62 to column 5 line 4).

With respect to claim 28, Kiest, Jr. et al. discloses that the swelling step further comprises forming the first seal (56) between the assembly (38) and circumferentially about an end of a tubular string (34) positioned in the branch wellbore.

With respect to claim 30, Kiest, Jr. et al. discloses the step of externally securing the sealing material on a tubular structure (see column 5 lines 55-66), and wherein the swelling step further comprises forming the first seal to provide a sealed flowpath between the branch wellbore and an interior of the tubular structure (see figures 3 and 4).

With respect to claim 31, Kiest, Jr. et al. discloses that the swelling step further comprises forming a second seal (58) between the tubular structure and the parent wellbore.

With respect to claims 32 and 33, Kiest Jr. et al. discloses that the second seal forming step comprises forming the second seal (56 or 58) above and below the window.

6. Claims 1, 3, 8, 10, 21, 26, 28, 30-34, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Meijers et al. (USP 5,340,160).

With respect to claim 1, Meijers et al. teaches positioning an assembly (6) in the window (3a); and swelling a sealing material (111) on the assembly by increasing a volume of the sealing material, so that a first seal is formed between the assembly and the window (see column 6 lines 22-32). Meijers does not disclose a method of completing a well. However, the assembly in Meijers is capable of being used in a wellbore, and it would have been obvious to use the assembly as taught by Meijers in a wellbore in order to form a seal between a main wellbore and a lateral bore in order to complete a wellbore.

With respect to claim 3, Meijers teaches the positioning step further comprises positioning the assembly at least partially in the parent wellbore and at least partially in the branch wellbore (see figure 8).

With respect to claim 8, Meijers teaches the sealing material is a rubber compound (see column 6 lines 22-32).

With respect to claims 10 and 36, Meijers et al. discloses that the sealing material swells in response to exposure to water in the well (see column 6 lines 28-32).

With respect to claim 21, Meijers et al. discloses a method of completing a well having a branch wellbore extending outwardly from a window in a parent wellbore, the method comprising the steps of: positioning an assembly (6) in the parent wellbore (see figure 8); forming an opening through a sidewall of the assembly (3a); aligning the assembly with the window (see figure 8); and swelling a sealing material (111) on the assembly by increasing a volume of the sealing material, so that a first seal is formed about the opening (see column 6 lines 26-32).

With respect to claim 26, Meijers et al. discloses that the aligning step further comprises aligning the opening with the window (see figure 8).

With respect to claim 28, Meijers et al. discloses that the swelling step further comprises forming the first seal (111) between the assembly (6) and circumferentially about an end of a tubular string (8) positioned in the branch wellbore.

With respect to claim 30, Meijers et al. discloses the step of externally securing the sealing material (111) on a tubular structure, and wherein the swelling step further comprises forming the first seal to provide a sealed flowpath between the branch wellbore and an interior of the tubular structure (see figure 8).

With respect to claim 31, Meijers et al. discloses that the swelling step further comprises forming a second seal (111) between the tubular structure and the parent wellbore.

With respect to claims 32 and 33, Meijers et al. discloses that the second seal forming step comprises forming the second seal (111) above and below the window.

7. Claims 1,3-13, 15-28, 30-40, and 42-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith et al. (USP 6,883,611) in view of Kiest, Jr. et al. (USP 6,994,118).

With respect to claim 1, Smith et al. discloses a method of completing a well having a branch wellbore extending outwardly from a window in a parent wellbore (see figure 3), the method comprising the steps of: positioning an assembly in the window (42); and swelling a sealing material (70) on the assembly (see column 5 lines 58-67), so that a first seal is formed between the assembly (42; wherein the seal is formed with 44 and the window, and 44 is part of 42) and the window (62). However, Smith et al. does not disclose that the volume of sealing material increases. Kiest, Jr. et al. discloses a seal which seals in the presence of a fluid, in order to form a water tight seal to prevent leakage. It would have been obvious to modify Smith et al. with the seals of Kiest, Jr. et al. by using a seal that expands in volume in order to form a tight, reliable seal.

With respect to claim 3, Smith et al. discloses that the positioning step further comprises positioning the assembly (42) at least partially in the parent wellbore and at least partially in the branch wellbore (see figure 3, wherein 44, which is part of assembly 42) is positioned in the parent wellbore and 42 is in the branch wellbore).

With respect to claim 4, Smith et al. discloses that the assembly is a tubular string (42), and wherein the positioning step further comprises deflecting the tubular string from the parent wellbore into the branch wellbore (see figure 3 wherein 42 is deflected off of whipstock 30).

With respect to claim 5, Smith et al. discloses the step of providing fluid communication between an interior of the tubular string (42) and the parent wellbore (12) via an opening formed through a sidewall of the tubular string (see figure 3).

With respect to claim 6, Smith et al. discloses that the swelling step further comprises forming a second seal between the tubular string and the parent wellbore (wherein seal 70 is formed above and below the window; see figure 7).

With respect to claim 7, Smith et al. discloses that the swelling step further comprises forming the first and second seals (70) on opposite sides of the opening (see figure 3).

With respect to claims 8, 18, 34, and 45, Kiest, Jr. et al. discloses that the sealing material is a rubber compound (see column 2 lines 10-14).

With respect to claims 9, 12, 35, and 39, Smith et al. in view of Kiest, Jr. teaches that the swelling step further comprises swelling the sealing material in response to exposing the sealing material to water. It would have been obvious to use a seal that expands in response to hydrocarbon fluid, as hydrocarbon fluid is the fluids found in wells.

With respect to claims 10, 13, 36, and 40, Kiest, Jr. et al. discloses that the sealing material swells in response to exposure to water in the well (see column 2 lines 43-49).

With respect to claim 11, Smith et al. discloses a completion system for a well having a branch wellbore extending outwardly from a window in a parent wellbore (see figure 3), the system comprising: a tubular string (42) having a portion positioned within

the window (see figure 3); and a sealing material (70) on the tubular string portion (see figure 3 and column 5 lines 58-67), the sealing material swelling in the well to thereby form a first seal (70) between the tubular string portion and the window (see figure 3 and column 5 lines 58-67). However, Smith et al. does not disclose that the volume of sealing material increases. Kiest, Jr. et al. discloses a seal which seals in the presence of a fluid, in order to form a water tight seal to prevent leakage. It would have been obvious to modify Smith et al. with the seals of Kiest, Jr. et al. by using a seal that expands in volume in order to form a tight, reliable seal.

With respect to claim 15, Smith et al. discloses that the tubular string portion (44) extends within the parent wellbore (12), the sealing material (70) forming a second seal between the tubular string portion and the parent wellbore (see figure 3).

With respect to claim 16, Smith et al. discloses that tubular string portion has an opening formed through a sidewall thereof (see figure 3), the opening providing fluid communication between an interior of the tubular string and the parent wellbore (see figure 3).

With respect to claim 17, Smith et al. discloses that the opening is positioned between the first seal and a second seal (70) formed by the sealing material between the tubular string portion and the parent wellbore (see figure 3).

With respect claim 19, Smith et al. discloses that the tubular string (42) extends into the branch wellbore (40) below the window (62), and wherein the tubular string (42) extends in the parent wellbore above the window (see figure 3).

With respect to claim 20, Smith et al. discloses that the sealing material (70) is a coating applied externally to the tubular string portion (see column 5 lines 58-67).

With respect to claim 21, Smith et al. discloses a method of completing a well having a branch wellbore extending outwardly from a window in a parent wellbore (see figure 3), the method comprising the steps of: positioning an assembly (42, which includes 44) in the parent wellbore (12; see figure 3, wherein 44 is in the parent wellbore); forming an opening through a sidewall of the assembly (62); aligning the assembly with the window (see figure 3); and swelling a sealing material on the assembly, so that a first seal is formed about the opening (see column 5 lines 58-67). However, Smith et al. does not disclose that the volume of sealing material increases. Kiest, Jr. et al. discloses a seal which seals in the presence of a fluid, in order to form a water tight seal to prevent leakage. It would have been obvious to modify Smith et al. with the seals of Kiest, Jr. et al. by using a seal that expands in volume in order to form a tight, reliable seal.

With respect to claim 22, Smith et al. does not disclose that the forming step is performed after the positioning step. However, determining the order of steps in a method of forming a branch borehole and positioning a tubular string in it requires only routine skill in the art. Therefore, it would have been obvious to one having ordinary skill in the art to modify Smith et al. so that the forming step is performed after the positioning step.

With respect to claim 23, Smith et al. discloses that the forming step is performed before the positioning step (see column 3 lines 26-32).

With respect to claim 24, Smith et al. does not disclose that the forming step is performed after the swelling step. However, determining the order of steps in a method of forming a branch borehole and positioning a tubular string in it requires only routine skill in the art. Therefore, it would have been obvious to one having ordinary skill in the art to modify Smith et al. so that the forming step is performed after the swelling step.

With respect to claim 25, Smith et al. discloses that the forming step is performed before the swelling step (see figure 3).

With respect to claim 26, Smith et al. discloses that the aligning step further comprises aligning the opening with the window (see figure 3, wherein the opening is aligned with the window).

With respect to claim 27, Smith et al. discloses that the swelling step further comprises forming the first seal (70) between the assembly (42) and the parent wellbore (12) circumferentially about the window (see figure 3).

With respect to claim 28, Smith et al. discloses that the swelling step further comprises forming the first seal (70) between the assembly (42) and circumferentially about an end (see figure 3) of a tubular string (42) positioned in the branch wellbore (40).

With respect to claim 30, Smith et al. discloses the step of externally securing the sealing material (70) on a tubular structure (64), and wherein the swelling step further comprises forming the first seal to provide a sealed flowpath between the branch wellbore and an interior of the tubular structure (see figure 3).

With respect to claim 31, Smith et al. discloses that the swelling step further comprises forming a second seal 70) between the tubular structure and the parent wellbore (12; see figure 3).

With respect to claim 32, Smith et al. discloses that the second seal forming step further comprises forming the second seal above the window (see figure 3, wherein there is seal 70 above and below the window).

With respect to claim 33, Smith et al. discloses that the second seal (70) forming step further comprises forming the second seal below the window (see figure 3, wherein there is seal 70 above and below the window).

With respect to claim 37, Smith et al. discloses that the aligning step further comprises engaging a latch of the assembly (42) with an orienting latch profile (20).

With respect to claim 38, Smith et al. discloses a completion system for a well having a branch wellbore extending outwardly from a window in a parent wellbore (see figure 3), the system comprising: an assembly positioned in the parent wellbore (42, which includes 44), the assembly having an opening (62) formed through a sidewall thereof (see figure 3), the opening (62) being aligned with the window (see figure 3); and a sealing material (70) on the assembly (42), the sealing material swelling in the well to thereby form a first seal circumferentially about the opening (see column 5 lines 58-67). However, Smith et al. does not disclose that the volume of sealing material increases. Kiest, Jr. et al. discloses a seal which seals in the presence of a fluid, in order to form a water tight seal to prevent leakage. It would have been obvious to

modify Smith et al. with the seals of Kiest, Jr. et al. by using a seal that expands in volume in order to form a tight, reliable seal.

With respect to claim 42, Smith et al. discloses that the sealing material forms a second seal between the assembly and the parent wellbore (see figure 3, wherein there is a seal 70 above and below the window).

With respect to claim 43, Smith et al. discloses that the first seal (70) is formed between the assembly (42) and the parent wellbore (12) circumferentially about the window (see figure 3).

With respect to claim 44, Smith et al. discloses that the first seal (70) is formed between the assembly (42) and an end of a tubular string (44) positioned in the branch wellbore (40).

With respect to claim 46, Smith et al. discloses that the assembly (42) includes a tubular structure (see figure 3), and wherein the first seal (70) provides a sealed flowpath between the branch wellbore (40) and an interior of the tubular structure (see figure 3).

With respect to claim 47, Smith et al. discloses that the sealing material (70) is a coating applied externally to the tubular structure (see column 5 lines 58-67).

### *Response to Arguments*

8. Applicant's arguments with respect to claims 1-47 have been considered but are moot in view of the new ground(s) of rejection. In view of the new rejections over newly found references Kiest, Jr. et al. and Meijers et al., this rejection is made non-final.

***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nicole Coy whose telephone number is 571-272-5405. The examiner can normally be reached on M-F 7:30-5:00, 1st F off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Bagnell can be reached on 571-272-6999. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

nac

William Neuder
Primary Examiner